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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,395	12/21/2000	Christopher J. Howard	3936P001D	4122

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EXAMINER	
ELISCA, PIERRE E	

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/745,395	HOWARD ET AL.	
	Examiner	Art Unit	
	Pierre E. Elisca	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *20,21 and 84-91* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *20,21 and 84-91* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office action is in response to Applicant's amendment, filed 12/15/2004.

2. Claims 20, 21, 23 and 84-91 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 20, 21, 23, 84, 85 and 86-91 are rejected under 35 U.S.C. 103 (a) as being unpatentable over **Glogau, Jordan (WO 9825373) in view of Kim et al. (U.S. Pat. No. 5,799,081).**

As per claims 20, 21, 23 and 86-91 Glogau substantially discloses a copy protection system/method that protects web sites (web sites or content distributed) and other works in computer readable form from unauthorized access and/or reproduction (which is readable as Applicant's claimed invention wherein it is stated that a method of receiving compensation for a security system for protecting content distributed on a network), comprising:

selling (terms and condition) a server security program to a content provider (see., abstract, or selling web sites to authorize user, page 19, lines 3-20, terms and condition);

selling a plurality of copies for a limited-use program to the content provider for licensing to users wishing to access the content (see., abstract, page 5, lines 6-20, page 9, lines 22 and 23, page 10, lines 1-24, page 11, lines 1-20, page 19, lines 3-20).

It is to be noted that Glogau fails to explicitly disclose the step wherein the server security program distributes the content to a client system if the client system has a limited-use client program and wherein the limited-use client program is configured to limit, in at least one way, non-ephemeral reproduction of the content at the client system distributed content is displayed by the limited-use client program. However, Kim discloses an illegal view/copy protection for a digital broadcasting including a reproducibility control field for limiting the reproduction of a copied program see., abstract, col 5, lines 64-67, col 6, lines 1-17. Applicant should note that the digital broadcasting of Kim can also be a one way communication or reproduction). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the copy protection method/system of Glogau by including the limitations detailed above as taught by Kim because this would prevent from being illegally viewed or copied to thereby protect its copyright.

As per claims 84 and 85, Jordan discloses a copy protection system/method that protects web sites (web sites or content distributed) and other works in computer

readable form from unauthorized access and/or reproduction (which is readable as Applicant's claimed invention wherein it is stated that a method of receiving compensation for a security system for protecting content distributed on a network), comprising:

providing network accessible protected content from a source (see., abstract, selling web sites to authorize user (or protected content or protected web sites, page 19, lines 3-20);

authorize downloading of protected content from a source to a client system (see., abstract, specifically wherein it is stated that upon passing the test, the copy protection system grants the end-user a license and enables the end-user to download software that facilitates access);

preventing, in at least one way and until compensation is received non-ephemeral reproduction of the downloaded content by the client system until compensation is received (see., page 5, lines 6-20, specifically wherein it is stated that a licensed or authorized end-user may download site copying software to an associated end-user computer system from the copy protection system server..).

It is to be noted that Glogau fails to explicitly disclose Applicant's newly added limitations wherein the server security program distributes the content to a client system if the client system has a limited-use client program and wherein the limited-use client program limits reproduction of the content at the client system in at least one way. However, Kim discloses an illegal view/copy protection for a digital broadcasting including a reproducibility control field for limiting the reproduction of a copied program

see., abstract, col 5, lines 64-67, col 6, lines 1-17. Applicant should note that the digital broadcasting of Kim can also be a one way communication or reproduction). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the copy protection method/system of Glogau by including the limitations detailed above as taught by Kim because this would prevent from being illegally viewed or copied to thereby protect its copyright.

REMARKS

5. In response to Applicant's arguments, Applicant argues that the prior art of record (Glogau and Kim) singularly or in combination fail to anticipate to render obvious the recited feature:

a. "wherein the limited-use client program is configured to limit one way reproduction of the content". However, the Examiner respectfully disagrees **since the limited-use client program limits or the limited-use client program is configured to limit is readable as the same**, and therefore this recited feature is disclosed by Kim in col 5, lines 64-67, col 6, lines 1-17. Applicant should note that the digital broadcasting of Kim can also be a one way communication or reproduction).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the copy protection method/system of Glogau by including the limitations detailed above as taught by Kim because this would prevent from being illegally viewed or copied to thereby protect its copyright.

b. Applicant argues that claim 85 is directed to a method of receiving compensation for distributing protected content, authorizing downloading of protected content from a source. As indicated above, Glogau discloses in the abstract, page 19, lines 3-20, terms and condition, and authorized access and/or reproduction upon passing the test, the copy protection system grants the end-user a license and enables the end-user to download software see., abstract, lines 5-8.

c. Applicant also maintains that Glogau and Kim cannot be combined, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071,5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Eli Lilli & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App & Inter);

and Es parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to Ex parte Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)"

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pierre Eddy Elisca

Primary Patent Examiner

February 9, 2005